

No. 11854

IN THE  
United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT

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RALPH E. JONES,

*Cross-Appellant,*

*vs.*

SCHICK SERVICE, INC., a corporation, and SCHICK, INC.,  
a corporation,

*Cross-Appellees.*

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OPENING BRIEF OF CROSS-APPELLANT.

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## OPENING BRIEF OF CROSS-APPELLANT.

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### I.

#### STATEMENT OF JURISDICTION.

Jurisdiction of the District Court in this action as to the patent claim alleged is founded upon the patent statutes of the United States [Combined Original and Supplemental Complaint, Tr. 8]. This stands admitted by reason of defendants' failure to deny it. Jurisdiction of the District Court as to the contract claim is founded upon the fact that the matter in controversy exceeds, exclusive of interest and costs, the value of \$3,000.00 and is between citizens of different states [Combined Original and Supplemental Complaint, Tr. 10], which is specifically admitted by defendants [Tr. 16].

Jurisdiction of the District Court is therefore founded upon Title 28, Sections 41 (1) and 41 (7) of the United States Code, and jurisdiction of this Court is founded upon Title 28, Section 225 of the United States Code.



II.

STATEMENT OF THE CASE.

A. The Issue.

The Combined Original and Supplemental Complaint sets forth two alternative claims for relief:

(a) A claim for relief for infringement of United States Letters Patent No. 2,228,768, issued to plaintiff, Colonel Ralph E. Jones, on January 14, 1941 [Tr. 8-9]; and

(b) A claim for relief for an accounting and royalties on an oral contract between plaintiff and defendant Schick, Inc., exclusively licensing said defendant under said patent No. 2,228,768 [Tr. 9-12].

Such claims for relief are pleaded in the alternative, and it is conceded by plaintiff that he cannot have judgment in his favor on both claims, as they are inconsistent. No election was required by the District Court between the inconsistent claims for relief in view of Rule 54 (c) of the Rules of Civil Procedure [Tr. 60].

The District Court found the existence of such oral license agreement between plaintiff and defendant Schick, Inc. [Tr. 55-57], but held that such contract was unenforceable because within the Statute of Frauds (Section 1624 of the California Civil Code, and Section 1973 of the California Code of Civil Procedure) because it could not have been fully performed within one year and, consequently, dismissed plaintiff's second claim for relief [Tr. 58, 61, 65]. This is one phase of plaintiff's present cross-appeal, and is discussed hereinafter.

The District Court also held that claims 1, 11, 26, 27, 28, 29 and 30 of said patent No. 2,228,768 are invalid



because of indefiniteness (presumably in view of Section 33, Title 35, of United States Code Annotated; Revised Statutes, §4888) [Tr. 59, 62], and this is the second phase of plaintiff's cross-appeal and is also discussed hereinafter.

## **B. The Facts.**

### **(1) CONTRACTUAL RELATIONS OF THE PARTIES.**

Plaintiff Ralph E. Jones is a retired colonel of the United States Army, having been retired from active duty in 1939 for physical disability [Tr. 112]. His patent in suit, No. 2,228,768, was issued on January 14, 1941, on an application filed on December 10, 1935 [Tr. 48].

Defendant Schick, Inc. (formerly named Schick Dry Shaver, Inc.), is a Delaware corporation [Tr. 44], and defendant Schick Service, Inc., is also a Delaware corporation, and is a wholly owned subsidiary of defendant Schick, Inc. [Tr. 43].

The patent in suit, No. 2,228,768, covers certain improvements in electric dry shavers [Tr. 48]. Defendant Schick, Inc., is a manufacturer of electric dry shavers, and sells the same to the public through defendant Schick Service, Inc., and otherwise.

The patent in suit, No. 2,228,768, issued on January 14, 1941. Almost immediately Mr. Hicks, patent counsel for Schick, Inc., noticed the patent in suit and called it to the attention of Mr. Merrick, vice-president and general counsel for defendant Schick, Inc. [Tr. 261]. Mr. Merrick, through a Los Angeles attorney, immediately arranged for a meeting with Colonel Jones at the latter's home in San Diego [Tr. 262], and traveling by all modern forms of transportation, "airplane, train, Super Chief, automo-

bile," Mr. Merrick went to San Diego and met there with Colonel Jones on January 24, 1941 [Tr. 261-262]. Before making this trip, Mr. Merrick was authorized by Schick, Inc., to purchase the patent in suit outright for \$50,000.00 in cash [Tr. 124-125, 261, 264] and, at the first meeting with Colonel Jones, Mr. Merrick suggested such an outright purchase but Colonel Jones declined this offer, stating that he wished to license and not sell his patent [Tr. 125]. Mr. Merrick stated that he had no authority to negotiate such a license and that Mr. Cordiner, president of defendant Schick, Inc., was in Hawaii on a vacation and would have to be present to negotiate such a license, and that he would attempt to arrange such a meeting between the plaintiff and Mr. Cordiner [Tr. 126, 264]. This was done.

A further meeting was held in Los Angeles on January 29, 1941, between plaintiff, Mr. Cordiner (president of defendant Schick, Inc.), and Mr. Merrick (its vice-president and general counsel) [Tr. 127, 265-266]. The District Court held that on that date plaintiff and defendant Schick, Inc. (through its president, Mr. Cordiner), entered into an oral contract by the terms of which plaintiff granted to Schick, Inc., an exclusive license under patent No. 2,228,768, in suit, for its life, and Schick, Inc., agreed to pay to plaintiff the sum of \$30,000.00 in cash as an advance against future royalties, and agreed to pay to plaintiff a royalty of  $1\frac{1}{2}\%$  of its sales price on all dry shavers sold by it under the patent until the total royalties so paid should total \$250,000.00, following which the royalty rate would automatically reduce to 1% on all such shavers thereafter sold during the life of the patent [Tr. 55-56]. The District Court found that at the time of making such oral contract, all of the terms thereof were

agreed to unconditionally by both parties, and that it was not conditioned upon any subsequent agreement as to further terms, or upon being reduced to writing, or otherwise [Tr. 56].

Immediately after the making of such oral agreement between the parties, Mr. Cordiner suggested that Colonel Jones could make any further suggestions as to further terms which he might wish by letter, and that upon receipt thereof Schick, Inc., would prepare a written draft for signature by the parties [Tr. 131, 272]. The next day, on January 30, 1941, he confirmed the oral agreement by a letter [Plaintiff's Exhibit 9] and with it sent a draft of an agreement which he had himself prepared [Tr. 255]. In answer to this, Mr. Merrick wrote an inquiry as to one of the terms [Plaintiff's Exhibit 10], and Colonel Jones answered this on February 10, 1941 [Plaintiff's Exhibit 11].

At the time of such oral agreement on January 29, 1941, Colonel Jones had two patent applications relating to dry shavers pending before the Patent Office, and had advised the representatives of Schick, Inc., of this fact, although he had not disclosed to them or had been asked, or had agreed to so disclose, any of the contents of such applications prior to the agreement.

By letter dated February 17, 1941, Mr. Merrick again wrote to Colonel Jones, this time requesting that Colonel Jones send to Schick, Inc., copies of plaintiff's pending applications [Plaintiff's Exhibit 12], and by letter dated February 20, 1941 [Plaintiff's Exhibit 13], plaintiff sent such applications to defendant in compliance with its request. The District Court found that such pending patent applications were secret and confidential and not open to the public, and that plaintiff sent copies thereof to Schick,

Inc., at its inducement and in reliance upon said oral contract, such reliance being induced by Schick, Inc.; that plaintiff would not have sent such copies to Schick, Inc., had he not relied upon such oral contract; and that by sending such pending patent applications to defendant Schick, Inc., plaintiff changed his position to his detriment and could not be put back into his original position after such disclosure [Tr. 57-58].

In addition, the District Court found that from January 29, 1941, until at least March 14, 1941, relying upon the acts and statements of defendant Schick, Inc., plaintiff believed that he had a binding and enforceable agreement with it, and in reliance thereon, plaintiff throughout such period refrained from negotiating with any other person or company with respect to his patent No. 2,228,768, here in suit, and thereby suffered further detriment [Tr. 58].

By letters dated March 13, 1941 [Plaintiff's Exhibit 14, Defendant's Exhibit C], defendant Schick, Inc., terminated all further dealings between the parties, and thereafter continued to manufacture and sell dry shavers embodying the invention defined by patent No. 2,228,768 without paying royalty thereon to plaintiff, which it is still doing.

## (2) DEFINITENESS OF CLAIMS.

The District Court held that claims 1, 11, 26, 27, 28, 29 and 30 are invalid because of indefiniteness. Such claims are quoted as follows:

"1. A hair clipping device of the character described, including an outer transversely slitted channeled head and a cutter reciprocating within the channel of the head, the head at its longitudinal outer

edges being transversely rounded, the transversely rounded surfaces merging into the outer surface of the head, and elements disposed at the ends of the channeled head, each having a longitudinally rounded surface at its extremity merging into the outer surface of the head at the ends thereof."

"11. A hair clipping device including a handle, a transversely slitted channeled head mounted on the handle and having a flat outer surface, a cutter reciprocating within the channel of the head, and elements carried by the handle and disposed at the ends of the head, each having a rounded surface at its extremity merging into the outer surface of the head at the respective ends thereof."

"26. A hair clipping device including a handle, an outer hollow cutting head having an outer face and side faces, a movable cutter disposed within the outer head, and guards mounted on the ends of the hollow outer head, each guard having a longitudinally and transversely rounded outer face merging into the outer face and the side faces of the cutter head whereby to provide rounded ends and corners for said head extending flush with the outer and side faces thereof.

"27. A hair clipping device including a handle, an outer hollow cutting head having an outer face and side faces, a movable cutter disposed within the outer head, and guards mounted on the ends of the hollow outer head, each guard having a longitudinally and transversely rounded outer face merging into the



outer face and the side faces of the cutter head whereby to provide rounded ends and corners for said head extending flush with the outer and side faces thereof, each guard being relatively thick at a point coincident with the inner end of the longitudinally curved portion of its face.

“28. A hair clipping device including a handle, an outer hollow cutting head having an outer face and side faces, a movable cutter disposed within the hollow head, guards disposed on the ends of the hollow head, each guard having a longitudinally and transversely rounded outer face merging into the outer face and the side faces of the cutter head whereby to provide rounded ends and corners for said head extending flush with the outer and side faces thereof, and means for detachably locking the cutting head to the handle.

“29. A hair clipper of the character described including a handle, an outer hollow cutting head having an outer transversely slitted face and side faces, a movable cutter disposed within the hollow head, guards mounted on the head and having a longitudinally and transversely rounded outer face merging into the slitted face and the side faces of the cutter head whereby to provide rounded ends and corners for said head extending flush with the outer and side faces thereof, and means detachably holding the head in place upon the handle.

“30. A hair clipper including a handle, a hollow cutting head disposed on said handle and having a transversely slitted wall and side walls and having a base resting flat against the end of the handle, guards

disposed at the end of the cutting head, each guard being relatively thick at its outer end and transversely and longitudinally curved to merge into the outer face of the slitted wall and the outer faces of the side walls of the head whereby to provide rounded ends and corners for said head extending flush with the slitted wall and outer faces of the side walls thereof, one of said guards at its inner end being attached to the handle, and means for holding the cutting head in place on said handle.”

The defendants offered no evidence whatever even tending to support the finding of “indefiniteness” as to either the disclosure or claims of patent No. 2,228,768 in suit.

On the other hand, defendants offered into evidence as Defendants’ Exhibit A a model of the dry shaver disclosed in patent No. 2,228,768 in suit, which was made under the direction of Mr. Gray, chief engineer for defendant Schick, Inc., and which Mr. Gray testified correctly illustrates the dry shaver disclosed in the patent in suit [Tr. 361]. The District Court found that the evidence wholly failed to show that Mr. Gray had any difficulty whatever in understanding the disclosure or claims of the patent in suit adequately to make the model, Defendants’ Exhibit A [Tr. 50].

Although requested to do so, the District Court made no finding or conclusion of law as to whether any of said claims 1, 11, 26, 27, 28, 29 and 30 are infringed by any of defendants’ devices in suit, exemplified by Plaintiff’s Exhibits 2, 3, 4 and 5.



III.

**SPECIFICATION OF ERRORS.**

The asserted errors of the District Court that will be relied upon by cross-appellant-plaintiff on this cross-appeal are as follows:

(1) The District Court erred in Finding of Fact 20, and Conclusion of Law 3, and in its Judgment, in finding and concluding that claims 1, 11, 26, 27, 28, 29 and 30 of patent No. 2,228,768 are invalid because of indefiniteness.

(2) The District Court erred in Conclusion of Law 6, as a matter of law, in concluding that the oral patent license contract between plaintiff and defendant Schick, Inc., was not fully or otherwise performed by plaintiff so as to take the contract out of the operation of the Statute of Frauds.

(3) The District Court erred in Conclusion of Law 6, as a matter of law, in concluding that defendant Schick, Inc., was not estopped from asserting the invalidity of said oral contract under the Statute of Frauds.

(4) The District Court erred in rendering judgment for defendant Schick, Inc., upon plaintiff's second claim for relief upon the contract.

IV.

SUMMARY OF THE ARGUMENT.

A. The District Court should have sustained plaintiff's second claim for relief upon said oral contract, because said contract was fully performed and executed by plaintiff and nothing remained to be done thereunder but the payment of royalties by defendant Schick, Inc. Under the law, this removes the oral contract from the operation of the Statute of Frauds.

B. The District Court should have sustained plaintiff's second claim for relief upon said oral contract, because in reliance upon the contract and at the inducement of defendant Schick, Inc., plaintiff changed his position to his detriment, and therefore, under the law, defendant is equitably estopped to rely upon the Statute of Frauds as a defense to plaintiff's action on the contract.

C. The District Court should have held claims 1, 11, 26, 27, 28, 29 and 30 of patent No. 2,228,768 in suit definite within the meaning of 35 U. S. C. A., §33 (R. S., §4888) and valid.

V.

THE ARGUMENT.

- A. The District Court Should Have Sustained Plaintiff's Second Claim for Relief on Said Oral Contract, Because Said Contract Was Fully Performed by Plaintiff and Nothing Remained to Be Done Thereunder but the Payment of Royalties by Defendant Schick, Inc.

The District Court found that on "Jan. 29, 1941, plaintiff and defendant Schick, Inc., entered into an oral contract by the terms of which plaintiff granted to said defendant an exclusive license under patent No. 2,228,768 for the life of that patent." [Tr. 55-56].

It is submitted that plaintiff upon granting to defendant the exclusive license fully performed all of his obligations under the contract and that nothing whatever remained to be done to complete the execution of the contract but the payment of money by defendant Schick, Inc., and that as a matter of law this places the oral contract outside of the operation of the Statute of Frauds.

It is well settled in California and elsewhere that the Statute of Frauds applies to executory contracts only, and that where the agreement has been fully performed by one party within a year of its making, it is not within the purview of the Statute. Moreover, the fact that the other party's performance will be required over a period in excess of a year is immaterial. The applicable California rule is stated in *Hellings v. Wright*, 29 Cal. App. 649, 656 (1916), as follows:

"As a matter of fact, plaintiff here performed his contract within the year, and so nothing was left but the payment of the consideration. 'When a contract

has been so far performed that nothing remains to be done but the payment of the consideration for the performance, the fact that the contract does not require the payment within a year furnishes no defense to an action for the price.' (20 Cyc. 296 (note 13 and cases there cited).)"

To the same effect *see: Dutton v. Interstate Inv. Corp.*, 119 P. (2d) 138, 141, 19 Cal. (2d) 65 (1941); *Wehner v. Bauer*, 160 Fed. 240, 244 (C. C. Cal. 1908); Restatement, Contracts, Sec. 198; 2 Williston, Contracts, Rev. Ed., 1936, Sec. 504, p. 1471.

Under the rule stated above, it has long been held specifically that an oral patent license agreement is not within the Statute of Frauds where the grant of the license has constituted complete performance by the patent owner, and all that remained to be done was the payment of money by the licensee. *See: Emerson v. Universal Products Company, Inc.*, 35 Del. 277, 162 Atl. 779 (Del. Sup. Ct. 1931); *Price v. Smith Manufacturing Company*, 53 Cal. App. 303, 200 Pac. 53 (1921); *Smith v. Neale*, 2 C. B. (N. S.) 67 (1857).

In upholding recovery under an oral patent license contract, the court in the *Emerson* case, *supra*, after a scholarly review of the applicable English and American decisions on the Statute of Frauds, concluded at page 781:

"The Statute of Frauds, we think, was only intended to operate upon agreements executory in character. The consideration moving to and the obligations assumed by each party made the agreement executory and when these obligations could not be performed within a year, the Statute of Frauds required that they be reduced to writing to be binding upon a party. When, however, the agreement contemplates one party immediately, fully and completely comply-

ing with his entire obligation and he does so immediately comply and there remains nothing to be done by the other but the payment of money pursuant to the agreement, then the agreement has ceased to be executory in character and has become executed.  
. . . .”

It is therefore respectfully submitted that the oral patent license contract between plaintiff and defendant Schick, Inc., is not within the Statute of Frauds, and that the District Court erred in refusing to award judgment to plaintiff on his second claim for relief.

**B. The District Court Should Have Sustained Plaintiff's Second Claim for Relief Upon Said Oral Contract, Because in Reliance Upon the Contract and at the Inducement of Defendant Schick, Inc., Plaintiff Changed His Position to His Detriment, and Therefore, Under the Law, Defendant Is Equitably Estopped to Rely Upon the Statute of Frauds as a Defense to Plaintiff's Action on the Contract.**

It is submitted that defendant Schick, Inc., is equitably estopped as a matter of law to raise as a defense the Statute of Frauds, the pertinent statutory provisions being as follows:

“§1624. (Statute of Frauds.) Contracts that must be written. The following contracts are invalid, unless the same, or some note or memorandum thereof, is in writing and subscribed by the party to be charged or by his agent:

“1. An agreement that by its terms is not to be performed within a year from the making thereof.  
. . . .”

California Civil Code, §1624.



“§1973. What agreements must be in writing. In the following cases the agreement is invalid, unless the same or some note or memorandum thereof be in writing, and subscribed by the party charged, or by his agent. Evidence, therefore, of the agreement, cannot be received without the writing or secondary evidence of its contents.

“1. An agreement that by its terms is not to be performed within a year from the making thereof.  
. . .”

California Code of Civil Procedure, §1973.

The District Court found: that *at the inducement of defendant* Schick, Inc., and in reliance upon the existence of said oral license contract, which reliance was also *induced* by Schick, Inc., plaintiff mailed copies of his two pending patent applications to Schick, Inc.; that plaintiff had never theretofore disclosed in whole or in part the contents of said pending patent applications to Schick, Inc.; that at that time such applications were secret and confidential; that plaintiff would not have sent copies of said pending applications to Schick, Inc., had he not relied on said oral contract; that by sending such applications to Schick, Inc., plaintiff changed his position to his detriment and could not be put back into his original position after such disclosure [Tr. 57-58].

The District Court also found that for a substantial period of time plaintiff, at the *inducement* of Schick, Inc., and in reliance upon the existence of said oral contract, which reliance was *induced* by Schick, Inc., refrained from negotiating with any other person or company with respect to patent No. 2,228,768 in suit, and thereby suffered further detriment [Tr. 58].

In view of the foregoing findings, it is submitted that as a matter of law defendant Schick, Inc., is equitably estopped to raise or rely upon the Statute of Frauds as a defense to plaintiff's claim for relief on the oral contract, and that the District Court's holding to the contrary is erroneous.

It is a well established legal doctrine, particularly in California, that where one party to an oral contract changes his position to his detriment, in reliance upon the oral contract, the other party is equitably estopped to raise the Statute of Frauds as a defense in an action on the contract by the first party. The general doctrine is stated in *Wilson v. Bailey*, 8 Cal. (2d) 416, 65 P. (2d) 770 (1937), as follows:

"The vital principle is that he who by his language or conduct leads another to do what he would not otherwise have done shall not subject such person to loss or injury by disappointing the expectations upon which he acted. Such a change of position is sternly forbidden. It involves fraud and falsehood, and the law abhors both."

This doctrine is also stated and applied in the cases of *Carpy v. Dowdell*, 115 Cal. 677, 47 Pac. 695 (1897); *Notten v. Mensing*, 3 Cal. (2d) 469, 45 P. (2d) 198 (1935); *Heffernan v. Davis*, 24 Cal. App. 295, 140 Pac. 716 (1914); *Keller v. Richbart*, 130 Cal. App. 296, 20 P. (2d) 55 (1933); *Feeny v. Clapp*, 126 Cal. App. 729, 15 P. (2d) 178 (1932); *Flint v. Giguere*, 50 Cal. App. 314, 195 Pac. 85 (1920); *Taylor v. Odell*, 50 Cal. App. (2d) 115, 122 P. (2d) 919 (1942); *Grant v. Long*, 33 Cal. App. (2d) 725, 92 P. (2d) 940 (1939).

It has also been held specifically that such equitable estoppel applies to oral patent license agreements. See:



*Price v. Smith Manufacturing Co.*, 53 Cal. App. 303, 200 P. 53 (1921).

It is to be noted that in the cases cited above the equitable estoppel is raised as a matter of law, *even though the change of position involved was not directly solicited by the party sought to be charged*. The facts in the present case are therefore much stronger in favor of plaintiff than in the cited cases, because *in this case the change of position by Colonel Jones was at the direct request of the defendant Schick, Inc.*

It is submitted that the action of the defendant Schick, Inc., trading on plaintiff's belief in the existence of the royalty contract, inducing plaintiff to reveal to it confidential and secret information contained in his pending patent applications (which plaintiff would not otherwise have done) is morally indefensible. It is submitted that ordinary business ethics required that, if the defendant corporation did not intend to abide by its royalty contract with plaintiff, it should have so notified him at the time that it requested him to make such disclosures. This defendant wholly failed to do so.

It is therefore submitted that plaintiff's disclosure of his two secret and pending patent applications to defendant Schick, Inc., and the fact that he forebore negotiating with others with regard to his patent No. 2,228,768. both at defendant's inducement, and in reliance upon the enforceability of his oral contract, constituted such a change of position by plaintiff as to equitably estop defendant Schick, Inc. from relying upon the Statute of Frauds as a defense.

The only reason, apparently, that the District Court refused to raise an equitable estoppel against defendant Schick, Inc. to rely upon the Statute of Frauds was that

the "patent applications Serial Nos. 314,287 and 316,154 [the applications that Colonel Jones sent to Schick, Inc. at its request] were not solely referable to the oral contract of January 29, 1941, *since it was not one of the terms or provisions of said oral contract that plaintiff would submit said patent applications or disclose them to defendant Schick, Inc.*" [Tr. 58]. In other words, the District Court took the view that there could not be any "equitable estoppel" without "part performance," and that the doctrine of "equitable estoppel" is merely one phase of the doctrine of "part performance." This, we submit, was erroneous. The correct rule is, we submit, that "part performance" is merely one phase of the general doctrine of "equitable estoppel." *See*: 49 Am. Jur., §§420-422, 582. That the change of position involved need not be in part performance of the oral contract is plain from the above and other decisions. Thus, in *Matzger v. Arcade Building & Realty Co.*, 80 Wash. 401, 141 Pac. 900, L. R. A. 1915A 288, the Court held that where a lessee under an oral lease purchased a stock in trade in reliance upon the existence of the lease, although not required to do so by the terms of his lease, and thereby changed his position to his possible detriment, the lessor was equitably estopped to rely upon the Statute of Frauds to defeat the oral lease.

It is submitted that such an equitable estoppel should be raised whether or not the change of position relied upon is in part performance of the contract provided, of course, that the change of position is: (a) detrimental; (b) is in reliance upon the enforceability of the oral contract; and (c) is at the inducement of the party sought to be charged. The facts in the present case clearly provide all of these requirements.

It is therefore respectfully submitted that by reason of the change of position of Colonel Jones at the inducement of defendant Schick, Inc., and in reliance upon the existence of the oral license contract, the defendant is equitably estopped to raise the Statute of Frauds as a defense to plaintiff's action on the oral license contract. To hold otherwise would plainly work a fraud upon plaintiff, and actually make the Statute of Frauds an instrument of fraud. Such is not its purpose.

**C. The District Court Should Have Held Claims 1, 11, 26, 27, 28, 29 and 30 of the Patent in Suit Definite and Valid as a Matter of Law.**

Although the District Court found such claims invalid for indefiniteness [Tr. 55, 59], no reasons were given by the District Court for such a general finding. On the other hand, the District Court specifically found:

"From the disclosure of patent No. 2,228,768, any man skilled in the art of dry shavers would immediately know the extent of such merging to be provided to accomplish the objects of the patent, and such term, when viewed in the light of the specification, is sufficiently definite and precise to provide such knowledge." [Finding 12, Tr. 50.]

The statute relating to definiteness of claims in a patent is 35 U. S. C. A., §33 (R. S., §4888), the pertinent portion of which is as follows:

" . . . and he [the inventor] shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

It is submitted that claims 1, 11, 26, 27, 28, 29 and 30 are all fully definite within the meaning of 35 U. S. C.

A., §33 (R. S., §4888), because they all distinguish from the prior art of record by structural limitations which are perfectly plain and definite. It is submitted that such claims on appeal are in nowise vague or indefinite.

Claim 1 of the patent in suit covers a combination of structural elements in a dry shaver (a "hair clipping device"), and includes the following:

" . . . and elements disposed at the ends of the channeled head, each having a longitudinally rounded surface at its extremity merging into the outer surface of the head at the ends thereof."

Such "elements," of course, are the hinged end guards 20 clearly shown in the drawing of the patent in suit, and plainly described in its specification. The District Court has held that the term "merging," as used in claim 1, is fully definite and precise (see quotation, *supra*). Mr. Gray, defendants' chief engineer, had no difficulty in making a model [Defendants' Exhibit A] of the device of the patent in suit, and he is conceded to be a "man skilled in the art." This quoted clause of claim 1 plainly defines the *form* and *position* of the outer surface of each of the guard elements. It is therefore submitted that claim 1 of the patent in suit, when viewed in the light of the drawing and specification, fulfills the requirement of the statute in that it distinctly claims the "part, improvement, or combination" which the patentee claimed as his invention therein.

Claim 11 of the patent in suit is submitted to be definite for the same reasons as advanced above with regard to claim 1. In addition, claim 11 specifically requires that the "elements" be "*carried by the handle*," which is an important distinction from the prior art and which

is specific to structure. No dry shaver or, in fact, any type of clipping device is shown in the prior art, which has such elements *carried by the handle*. The importance of this feature is clearly established by the fact that Schick, Inc. has always mounted its guard elements ("Whiskits") on the handle, and not on the cutting head [Tr. 390], even though it owns a patent to Meyer [Defendants' Exhibit L-2] covering mounting the guards on the cutting head. This limitation that "elements" are "*carried by the handle*" does not render the claim functional as it does not describe any *function* which the element performs but on the contrary distinctly defines the *position* of the element.

Claims 26, 27, 28, 29 and 30 of the patent in suit are all submitted to be fully definite as to the novel structure involved for the same reasons advanced above with regard to claim 1. In addition, each of these claims specifies that the cutting head has an *outer face* and *side faces* and that the guards ("elements") are also rounded transversely so as to *merge into the side faces*. As the District Court has found that the term "merging" is fully definite and precise, and since the prior art fails to suggest any such structure, it is submitted that all of such claims are clearly definite and valid by reason of such additional structure not included in claim 1. In addition, claims 27 and 30 provide that each guard is *relatively thick* at its inner end (*i.e.*, that it is thicker at its inner end than at its outer end), which is an additional structural limitation not suggested by the prior art.

We do not know the reason why the District Court held the appealed claims fatally indefinite. The courts have repeatedly refused to apply any such general holding of indefiniteness, and, in fact, have repeatedly held claims of the same general type here on appeal to be valid



against the contention of "indefiniteness." The doctrine of "indefiniteness" has been refused application recently by this Court in *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 F. (2d) 91 (C. C. A. 9th, 1945), in which this Court held claims definite and valid, even though they contained a number of "functional terms." Also see: *Research Products Co. v. Tretolite Co.*, 106 F. (2d) 530 (C. C. A. 9th, 1939). Other recent decisions to the same effect are indicated by the following quotations.

" . . . The claims of a patent are always to be interpreted in the light of its specifications and drawings. This canon of construction is as old as the patent law itself and finds its latest pronouncement in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211, 217, 61 S. Ct. 235, 85 L. Ed. 132. The District Court did not in its findings point out the particular feature or lack of feature in the specifications which subjected the claims to uncertainty.

. . .

"As indicated at the outset, we have not been aided in our examination of the record either by brief or by argument of counsel for appellee, but we find nothing that indicates a fatal lack of compliance with Title 35, ch. 2, Sec. 33, U. S. C. A. The presumptions of validity arising from the grants are not negatived. We are not authorized to strike down a patent for uncertainty and indefiniteness where a reasonable construction of the specifications and claims will protect the invention. *Cleveland Automatic Mach. Co. v. National Acme Co.*, 6 Cir., 52 F. 2d 769, 771. Laying to one side any other construction, we are reasonably satisfied that the patents here involved are sufficiently described and claimed."

*Paul E. Hawkinson Co. v. Wilcoxon*, 149 F. (2d) 471, at p. 475 (C. C. A. 6th, 1945).

“It has been strenuously argued that all of the claims of this patent are invalid because the disclosure rested in vital particulars upon no more certain terms of description of the shear-plate than ‘thin,’ ‘extremely thin,’ ‘so thin that it would collapse or flex under inward pressure.’ It is said that there is no adequate disclosure of what thickness of shear-plate is to be used and also that it is not a good limiting description to say in respect to the distance between shear-plate blades that they ‘are too close together, however, to allow the skin to pass up into the slots 14 and the skin is therefore safe from cutting.’ Also that the distance between such blades may not be given as of the ability to admit hair as a minimum and of the ability to exclude skin from the cutting area as a maximum. Though such argument is, indeed, plausible in the sense that some experimentation would seem to be required in amplification of the disclosure, it must be remembered that in making the cutting head of a dry shaver such distances as those of a hair’s breadth are those with which the maker of the shaving head is immediately concerned and it is, perhaps, the exact opposite of vagueness and uncertainty to express such distances in terms of the thickness of hair. At least it may be recalled that to express minute distances in terms of the breadth of a hair is not uncommon. So too, it is fair to say that if one skilled in the art is told to make the blades too close together to permit the skin to pass up into the slots far enough to be in danger of being cut he would know what that meant. The specifications are to be read fairly in connection with the claims and a reasonable construction given the language used to the end that whatever invention is actually disclosed and claimed will be protected. *Smith v. Snow*, 294 U. S. 1, 55 S. Ct. 279, 79 L. Ed.



721; *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 14 S. Ct. 295, 38 L. Ed. 103. When so read the language is as definite as the law requires. These two claims are, therefore, valid."

*Schick Dry Shaver, Inc., et al. v. R. H. Macey & Co., Inc.*, 111 F. (2d) 1018, at pp. 1021-1022 (C. C. A. 2nd, 1940).

"The patent is challenged on the ground of generality for failure to furnish a yardstick with which to determine the meaning of 'long,' 'narrow' or 'thin' teeth. The contention does not require extended discussion. It is difficult, if not impossible, to state in general terms an abstract rule by which to test objectionable indefiniteness or generality in a patent. Each case must be determined in large measure by its own facts. This patent is in a well known and crowded art; and the specifications and drawings throw significant light upon the meaning with which the words are used. When the prior art, the specifications, and the drawings are taken into consideration in connection with the claims, the patent is not open to the objection of being too indefinite or general to disclose how the invention may be put to use and how infringement may be avoided. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523; *Vacuum Cleaner Co. v. Innovation Electric Co.*, 2 Cir., 239 F. 543."

*Chicago Pneumatic Tool Co. v. Hughes Tool Co.*, 97 F. (2d) 945, at p. 948 (C. C. A. 10th, 1938).

“The patent in suit clearly discloses that the patentees did not intend that their bucket should have a flat bottom or a curved bottom with tangent lip, but that the bottom should have a flowing or graduated curve conforming substantially to a segment of a logarithmic spiral as illustrated in the drawing.

“It is to be noted that no one skilled in the art testified that there would be any difficulty in producing the kind of bucket disclosed by the patent. Compare *Donner v. Sheer Pharmacal Corporation*, 8 Cir., 64 F. 2d 217, 220, 221.

“The court below was justified in finding as a fact that the patent was not fatally defective in its disclosure of the invention claimed.”

*Strong-Scott Mfg. Co. et al. v. Weller et al.*, 112 F. (2d) 389, at p. 395 (C. C. A. 8th, 1940).

“ . . . Where, as appears to be true in this case, the patentee does not intend a flat bottom, the expression used is not happy. The language of the specification does not cover the point, and from it no one can say how near flat the bottoms of the buckets were intended to be. But the drawings, which are part of the specifications (*Lamb Knit Goods Co. v. Lamb Glove & Mitten Co.*, 120 F. 267-269 (6 C. C. A.)), clear up the ambiguity. Fig. 2 shows a slightly concave bottom. The patentee could select his own language, but was bound to make his meaning reasonably plain and specific. Taking the drawing into account, I think he has done so. He shows that by ‘substantially flat’ he meant a slight departure from

flatness by concavity, and neither a convex nor corrugated surface. . . .”

*Westco-Chippewa Pump Co. v. Auto-Prime Pump Co.*, 57 F. (2d) 556, at p. 559 (D. C., N. D. Ohio, E. D., 1931).

It is submitted that claims 1, 11, 26, 27, 28, 29 and 30 of the patent in suit are all specific to structural elements which plainly distinguish the patented device from the prior art, that there are *no* terms in any of the appealed claims which are indefinite or vague in any respect to either a layman or a man skilled in the art, and that the meaning of every term in the claims is self-evident from the specification and drawing of the patent in suit. It is submitted that there are no findings by the District Court that support the judgment that such appealed claims are invalid for lack of definiteness but, in fact, the District Court's findings clearly show that the claims are fully definite. If the defendants in this case contend that such appealed claims are “indefinite” in any respect, we submit that it is incumbent upon them to point out with particularity in their answering brief each and every portion of the claims upon which they will rely in support of such a contention.

It is submitted that the holding of the District Court that claims 1, 11, 26, 27, 28, 29 and 30 are indefinite and therefore invalid is erroneous as a matter of law and should be reversed by this Court.

VI.

CONCLUSION.

It is submitted that judgment should be rendered for plaintiff on his second claim for relief upon the oral patent license contract because: (a) The contract was not within the Statute of Frauds; and (b) because defendant Schick, Inc., is equitably estopped to raise or rely upon the Statute of Frauds as a defense to such action.

It is also submitted that claims 1, 11, 26, 27, 28, 29 and 30 of the patent in suit are perfectly definite and valid.

It is therefore respectfully submitted that the judgment of the District Court should be modified to (a) sustain plaintiff's second cause of action on the royalty contract and to award plaintiff an accounting and judgment as to royalties due; or (b) alternatively, hold claims 1, 11, 26, 27, 28, 29 and 30 of the patent in suit valid.

Respectfully submitted,

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